

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 46320
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Ronald DOYLE, et al.	:	Confirmation Number: 6219
	:	
Application No.: 10/612,583	:	Group Art Unit: 2113
	:	
Filed: July 1, 2005	:	Examiner: E. Mehrmanesh
	:	
For: SMART EVENT PARSER FOR AUTONOMIC COMPUTING	:	

Mail Stop Amendment
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION

Sir:

The following Remarks are submitted in response to the Office Action dated March 21, 2006.

REMARKS

At the time of the Office Action dated March 21, 2006, claims 1-15 were pending and rejected in this application.

CLAIMS 1-15 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY CUDDIHY ET AL., U.S. PATENT NO. 5,463,768 (HEREINAFTER CUDDIHY)

On pages 2-8 of the Office Action, the Examiner asserted that Cuddihy discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure of each element of a claimed invention in a single reference.¹ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.² This burden has not been met. Moreover, the Examiner has failed to clearly designate the teachings in Cuddihy being relied upon the statement of the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c), which reads:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

² Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., *supra*.

Despite this requirement, the Examiner's statement of the rejection simply consists of the Examiner repeating, almost word-for-word, entire passages of each of the recited claims and asserting that the entire passage is disclosed by certain specified passages within Cuddihy. The manner in which the Examiner conveyed the statement of the rejection, however, has not "designated as nearly as practicable" the particular parts in Cuddihy being relied upon by the Examiner in the rejection. Moreover, the Examiner has not clarified what particular teachings within Cuddihy identically disclose each of the claimed elements.

Claims 1 and 10

For example, the Examiner cited column 8, lines 47-55 to teach the claimed "interrelated components and resources." However, the passage cited by the Examiner is completely silent with regard to both interrelated components and resources. The Examiner also cited column 4, lines 10-24 to teach the claimed "uniform convention for naming dependent ones of the interrelated components and resources," yet upon reviewing this passage Applicants are unable to determine where such a teaching is found within Cuddihy.

On page 3 of the Office Action, the Examiner cited column 6, lines 34-39 to teach several claimed features. This passage only teaches the creation (and formatting) of a new error log 58 based upon identified blocks within a database 15, which does not identically disclose the claimed "parsing a log ... to determine whether said error condition arose from a fault in one of the interrelated components." The Examiner also cited column 4, lines 10-32 to teach the claimed "resources named in said associated log," and again, Applicants are unable to determine where such a teaching is found within Cuddihy. As to the claimed "further parsing a log ... to

identify a cause for said fault," the Examiner cited column 3, lines 57-59. This passage only teaches that the error logs include a malfunction description, which does not explicitly or inherently teach that the cause of the error has been identified.

As to the claimed "correcting said fault," Applicants have reviewed the several passages cited by the Examiner and are unable to find a teaching that of the claimed "correcting said fault," which is to be performed autonomously, as recited in the preamble of claims 1 and 10. Therefore, for the reasons presented above, the Examiner has failed to establish that Cuddihy identically discloses the claimed invention, as recited in claims 1 and 10, within the meaning of 35 U.S.C. § 102.

Claims 2-3 and 11-12

The Examiner's cited passages are silent at to the "analysis code [being inserted or activated] in said specific one of the components responsive to detecting said error condition," as respectively recited in claims 2-3 and 11-12. Also, as noted above, column 3, lines 57-59 does not teach identifying a cause for the error condition.

Claim 4-5 and 13-14

Claims 4-5 and 13-14 also recite "inserting analysis code," and Applicants incorporate herein the arguments previously presented with regard to claims 2-3 and 11-12. Moreover, claims 4 and 13 also recite inserting the code into "resources," the teaching of which the Examiner has failed to establish that Cuddihy discloses.

Claims 6 and 15

The Examiner's citations of column 6, lines 34-44 and column 7, lines 57-59 are completely silent with regard to the limitations recited in claims 6 and 15.

Claim 7

Applicants incorporate herein the arguments previously presented with regard to the claimed "standardized naming conventions for the interrelated components and resources." Moreover, the Examiner has not distinguished the teaching of the claimed "associated ones of the interrelated components and resources" and the claimed "dependent ones of the interrelated components and resources."

The above argued differences between the invention defined in claims 1-15 and disclosure of Cuddihy undermine the factual determination that Cuddihy identically describes the claimed invention within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully submit that the imposed rejection of claims 1-15 under 35 U.S.C. § 102 for anticipation based upon Cuddihy is not factually viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: June 21, 2006

Respectfully submitted,

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CUSTOMER NUMBER 46320